

REMARKS/ARGUMENT

Applicants are filing the present Amendment as a submission with an RCE in accordance with 37 CFR §1.114. The period for response expired upon the mailing date of the Advisory Action, October 5, 2004. The Advisory Action incorrectly notes that the period for response expired 3 months from the date of the Final Office Action. Applicants filed a Response within 2 months of the Final Office Action.

Claims 1, 12-13, 15-20, 22-23, 33, 35-36, 38, 40-41, 46, 48-52, and 54 are pending after entry of the present Amendment.

Claim Objections

Claim 53 was objected to because of noted informalities. Claim 53 is herein canceled.

Rejections under 35 U.S.C. §103

Applicants' claims 1, 11, 12, 23, 33, 46-48, and 53-54, were rejected under 35 USC §103(a) as being unpatentable over Joffe et al, (U.S. Patent No. 6,185,619) in view of Adams (US Patent No. 6,055,568). The claim rejections are traversed, and Applicants request reconsideration in light of claim amendments and argument.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. (MPEP §2143). The mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggest the desirability of the combination. That is, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. Applicants respectfully submit a *prima facie* case of obviousness is not supported against Applicants' claimed invention.


Regarding Applicants' independent claim 1, Applicants respectfully submit that the asserted combination fails to teach or suggest all the claim limitations as recited. Applicants have amended independent claim 1 to positively recite that the collecting of data is done periodically, and that the selecting of the at least one computer to be the selected computer is completed independent of the search query from the user. In other words, the collection of data, and the identification of one or more selected computers in the peer-to-peer network is an on-going, continuous process that is, initially, independent of any search query by a user/participant in the peer-to-peer network. Examiner is directed to page 21, lines 7-17. Specifically, Applicants have described "the host monitor outputs its collected status information to the host selector 250. The host selector uses this data in step 415 to compile a list of, for example, ten hosts which are most likely to provide favorable search results. *Thereafter*, a user may connect to the host selector in step 420, in order to receive the list of the ten hosts" (emphasis supplied).

The search methods and systems described and claimed by Applicants continuously monitor and collect data about connected computers on a periodic basis to select the best peer systems for search. The combination of references asserted by the Office fails to teach or suggest these features. Specifically, Joffe et al. teach a method of identifying a likely content server, or priority of content servers, *in response to* a client request for data. The entire process taught by Joffe et al., some of which contains features in common with Applicants, is conducted or processed in response to each individual client request. Applicants are teaching a different process which is constant or on-going, and independent of the search query. That is, Applicants have described and claimed methods and systems in which likely servers are already identified whether or not a search query has been formulated. If a search query is formulated, the method can be further refined with more content specific information and cache, but the basic method remains independent of the search query. Even if the method of Joffe et al. is modified as asserted by the Office according to Adams, the method of Joffe et al. still teaches a search and content server identification in response to a client query. The asserted combination fails to teach each and every feature as claimed by Applicants.

Applicants have amended each of independent claims 1, 23, and 46 to recite the periodic data collection, and the selection independent of a search query as described above. All other previously pending independent claims, except 1, 23, and 46, have been canceled. The asserted combination of Joffe et al. in view of Adams fails to teach each and every element of Applicants' independent claims 1, 23, and 46, and likewise fails to teach each and every element of the dependent claims depending therefrom. Applicants therefore respectfully request reconsideration, and withdrawal of the §103 rejections.

In view of the foregoing, Applicants respectfully request reconsideration of claims 1, 12-13, 15-20, 22-23, 33, 35-36, 38, 40-41, 46, 48-52, and 54. Applicants submit that all claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. If Examiner has any questions concerning the present Amendment, the Examiner is kindly requested to contact the undersigned at (408) 749-6900, ext. 6905. If any additional fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. ROXIP280). A copy of the transmittal is enclosed for this purpose.

Respectfully submitted,
MARTINE & PENILLA, L.L.P.


Rick von Wohld, Esq.
Reg. No. 48,018

MARTINE & PENILLA, LLP
710 Lakeway Drive, Suite 170
Sunnyvale, California 94085
Customer Number 25920